

U.S.S.N. 10/065,986

IN-5533

REMARKS

After entry of the subject amendment, claims 1 and 5-14 remain in the application with claim 1 in independent form. More specifically, claims 1, 5, 6, and 7 have been amended, claim 2 has been cancelled (claims 3 and 4 previously cancelled), and claims 9-14 have been added in this amendment. There is full support in the specification for the amendments to claims 1, 5, 6, and 7 and for added claims 9-14. New claims 9 and 10 are merely reintroductions of original dependent claims 3 and 4. Support for new claims 11-14 can be found in Figures 1A and 1B and in Paragraphs [0011] and [0021] of the published application. Accordingly, no new matter has been added.

Claim 1 stands objected to due to a minor informality. Due to the current amendments to claim 1, it is believed that this objection is overcome.

Claims 1, 2, and 5-8 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Rosa (United States Patent No. 5,518,561). Claims 1 and 2 stand rejected under 35 U.S.C. § 102(b) as being anticipated by JP 11-059267 (referring to the English language abstract for the reference). Claims 1, 2, and 5 are rejected under 35 U.S.C. § 102(e) as being anticipated by Abe et al. (United States Patent No. 6,441,551). Finally, claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Abe et al.

Independent claim 1 has been amended to further clarify the subject invention. More specifically, claim 1 now recites, among other elements, an automotive body panel and that the electroluminescent (EL) phosphor in the color-providing film layer is excited by electrical induction.

These amendments were already in the claims ('the automotive body panel' via previous amendment and 'the excitation by electrical induction' as original claim 2). As such, the current amendments do not raise new issues that require further consideration and/or search and they should, therefore, be entered. To this end, the Applicant further notes the procedures regarding an amendment filed under §116. These procedures specifically recognize that amendment placing the application in condition for allowance or in better form for consideration on appeal may be admitted. As stated at MPEP Section 714.13, the proposed amendment should be given sufficient consideration to determine

U.S.S.N. 10/065,986

IN-5533

whether the claims are in condition for allowance and/or whether the issues on appeal are simplified.

As described in detail below, the Applicant respectfully traverses the Examiner's rejections of original dependent claim 2, the substance of which has now been amended into independent claim 1, and notes that the claims are now in condition for allowance.

The amendments to claim 1 described above require that the EL phosphor in the color-providing film layer be excited by electrical induction. Referring to Paragraph [0020] of the original specification (see Paragraph [0020] of the published application), although the EL phosphor may be excited by direct electrical contact, it is preferred that the EL phosphor is excited by electrical induction. This preference exists primarily because electrical induction, as opposed to direct electrical contact, would reduce any potential for any shock hazard due to the existence of exposed contacts (the contacts would be required for direct electrical contact), and would reduce any potential for corrosion of the contacts associated with direct electrical contact.

In contrast to the claimed invention, Rosa does not disclose, teach, or otherwise suggest an EL phosphor in a color-providing film layer that is excited by electrical induction as suggested by the Examiner in her Office Action. Instead, referring to Figure 3 and Column 4, lines 16-19, Rosa very clearly relies on contacts (45 and 47) associated with direct electrical contact, not electrical induction. Similarly, JP 11-059267 and Abe et al. do not disclose, teach, or otherwise suggest an EL phosphor in a color-providing film layer that is excited by electrical induction. Instead, with respect to JP 11-059267, this reference is completely silent about "electrical induction" and suggests that direct electrical connection (rather than electrical induction) is accomplished by lead wires (10 and 12) in direct electrical connection with electrode layer (18). As such, just like the direct electrical connection of Rosa, JP 11-059267 would be particularly susceptible to shock hazard and corrosion of contacts...especially if it were to be utilized on an automotive body panel. Finally, referring to Figures 1, 3, and 4; Column 2, lines 1-21; and more importantly Column 10, line 48 - Column 11, line 9, Abe et al. is also completely silent about "electrical induction" and suggests series or parallel direct

U.S.S.N. 10/065,986

IN-5533

electrical connection utilizing terminals, i.e., contacts.

The Examiner's previous response relating to *direct* application adjacent the substrate and use of the claim term "comprising" are no longer applicable in view of the original scope of claim 2, now in amended independent claim 1, relating to the EL phosphor excited by electrical induction and in view of the fact that the prior art does not anticipate this claimed feature. Furthermore, in addition to the arguments set forth above, it is worthy to note that Abe et al. and the English language Abstract of JP 11-059267, as relied upon by the Examiner, do not disclose an automotive body panel as claimed in amended independent claim 1.

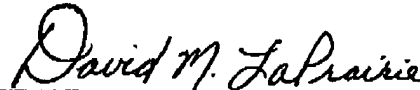
In view of the amendments to independent claim 1, the Examiner's § 102 rejections of original dependent claim 2, now part of independent claim 1, are overcome. Furthermore, because any relevant prior art does not teach or suggest excitation of an EL phosphor by electrical induction in a coating system on an automotive body panel and because this claimed feature clearly provides unique advantages to coating systems on automotive body panels, it is respectfully submitted that any potential § 103 rejection by the Examiner would be misplaced. To this end, the subject Rule 116 Amendment should be admitted and claim 1 is allowable. The remaining claims depend, either directly or indirectly, from claim 1 such that these claims are also allowable.

It is respectfully submitted that the application is now presented in condition for allowance, which allowance is respectfully solicited.

The Commissioner is authorized to charge Deposit Account No. 08-2789 for any additional fees or to credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.



David M. LaPrairie, Registration No. 46,295
The Pinehurst Office Center, Suite 101
39400 Woodward Avenue
Bloomfield Hills, Michigan 48304-5151
(248) 723-0442

Date: October 8, 2004

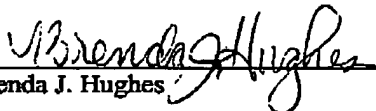
H&H 65,241-060

U.S.S.N. 10/065,986

IN-5533

CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the attached **Amendment After Final** is being facsimiled to the United States Patent and Trademark Office addressed to **Examiner Dawn L. Garrett**, at **Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450**, facsimile number (703) 872-9306, on this 8th day of **October, 2004**.


Brenda J. Hughes

G:\B\BASF\AutoCoatings\Ip0060\Patent\116 Amendment After Final.doc

H&H 65,241-060

7